

Navy Case No. 82,627

PATENTS



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
Louis F. Aprigliano et al. :
Serial No. 09/656,017 : Group Art Unit: 1722
Filed: Sept. 7, 2000 : Examiner: K. Lin
For: METHOD OF PRODUCING CORROSION : CONFIRMATION NO. 2288
RESISTANT METAL ALLOYS WITH :
IMPROVED STRENGTH AND DUCTILITY : GROUP DIRECTOR

PETITION UNDER RULE 181

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

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DEC 19 2001
TC 1700

Pursuant to 37 CFR 1.181 and Sections 706.07(c)(d) and 1002(c) M.P.E.P., applicants hereby petition the Commissioner with respect to ex parte prosecution of the above entitled application.

STATEMENT OF FACTS INVOLVED

1. On Oct. 1, 2001 an Office action on the merits was mailed, in which claims 1-3 and 5-8 were rejected under 35 U.S.C. 103(a) supported by reasons set forth therein based on a combination of certain prior art references of record relied on.
2. On Oct. 17, 2001 an amendment was filed in response to the Office action of Oct. 1, 2001, wherein limitations were added to claims 1-3 and 5-8 in an effort to further distinguish over the prior art references relied on and thereby overcome the reasoning set forth in the latter Office action to support their rejection. Such limitations added include for example a qualitative expression set forth in claim 2 that the selected corrosion resisting material has a component that is limited to: "chromium constituting between 48% and 52% of weight of the alloy--".

3. On Nov. 8, 2001 a final Office action was mailed, wherein claims 1-3 and 5-8 were finally rejected over the same prior art references previously relied on, based on "--the same reasons as set forth in the last Office action". No other reasoning was stated to support such final rejection except for the statement that: "one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references".

4. On Nov. 15, 2001 applicants filed a paper entitled "Request For Reconsideration and Withdrawal of Finality of Final Office Action". In such paper, applicants' not only requested favorable reconsideration but also expressly requested: "Withdrawal of the finality of the Office action--pursuant to Section 706.07(d) M.P.E.P.", because the Final Office action failed to either refer to or comment on any of the limitations added to the claims prior to their final rejection.

5. On Dec. 5, 2001 an Advisory Action was mailed, wherein only the request for favorable reconsideration was denied on the stated basis that a limitation (which was added to claim 7) "is a qualitative expression", allegedly possessed by the prior art of record.

Points To Be Reviewed

1. Did the Examiner fully consider and point out in the Final Office action wherein the limitations added to claims 1-3 and 5-8 prior to their final rejection fail to overcome the previous rejection?

2. Did the Examiner explain in the Advisory action following the Final Office action, wherein any consideration was accorded applicants' request for withdrawal of the finality of the final Office action?

3. Do the facts of record in this case, as hereinbefore referred to, establish that the finality of the Final Office action is premature?

Remedial Action Requested

It is requested that the finality of the Final Office action dated Nov. 2, 2001 be withdrawn and prosecution reopened with respect to claims 1-3 and 5-8 as presently amended.

Memorandum In Support of Petition

It is clear from the record in this case as outlined herein that the Examiner did not accord consideration in the Final Office action to all of the limitations added to claims 1-3 and 5-8 prior to the Final Office action, which is therefore incomplete and premature. Such failure to accord consideration to the added limitations is virtually conceded by the Examiner in the Final Office action, in expressly stating that such final rejection is based on the "same reasons as set forth in the last Office action".

Because of the foregoing referred to situation, applicants expressly requested completion of the premature final Office action. In response to such request, the Examiner merely referred to the added limitations as including an allegedly "qualitative expression", in contrast to an obviously qualitative expression set forth in claim 2 as hereinbefore quoted.

Conclusion

In view of the foregoing, the requested remedial action is in order and is hereby sought in advance of the Feb. 8, 2002 deadline for appeal.

The Petition fee of \$130.00 is requested to be charged to Deposit Account No. 50-0958.
Please charge any additional fees or credit overpayments to the same deposit account. (A
duplicate copy of this petition is therefore forwarded herewith for accounting purposes).

Respectfully submitted,



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